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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/209,815	12/11/1998	ROBERT A. FERSTENBERG	2566-158	6481

6449 7590 11/12/2004

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EXAMINER

MYHRE, JAMES W

ART UNIT PAPER NUMBER

3622

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/209,815

Applicant(s)

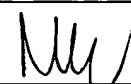
FERSTENBERG ET AL.

Examiner

James W Myhre

Art Unit

3622



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 116-121, 123, and 125-147 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 116-121, 123 and 125-147 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 127, 128, 139, 146 and 147 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 1998 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. In view of the Decision by the Board of Patent Appeals and Interferences on June 18, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of objection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Objections***

2. Claims 127, 128, 139, 146, and 147 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The above claims are written in dependent format (referencing a prior method claim). However, the claims do not further limit the steps involved in the parent method claim.

For example, Claim 116 is a method claim which includes the steps (a) generating electronic opening messages; (b) generating electronic offer messages; (c) generating electronic counter-offer messages; and (d) repeating steps (a) through (c) as necessary. Claim 127 is a dependent claim which does not add, delete, or alter any of the steps of the parent claim; thus, "fails to further limit the subject matter of a previous claim". The Applicant's arguments in the Appeal Brief filed on January 10, 2003 that the claim further limits the parent claim by storing program instructions in a memory is not persuasive. First, the claim does not include the limitation of actually performing the storing steps, but merely discloses that such program instruction are already stored thereon. Furthermore, even if the step of actively storing the program instruction into the memory was included in the claim, it would not further limit the invention of electronic intermediated exchange of a plurality of commodities among a plurality of participants. In order to overcome this objection, the Examiner suggests the Applicant either cancel these claims or else rewrite them in proper independent format and pay the appropriate fees. (The Examiner notes rewriting Claims 127 and 147 as proper independent claims would overcome the objection for Claims 128 and 147 which respectively depend thereon.).

***Allowable Subject Matter***

3. Claims 116-121, 123, and 125-147 are allowed.

4. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

### ***Drawings***

5. The drawings filed on December 11, 1998 are acceptable subject to correction of the informalities indicated on the "Notice of Draftsperson's Patent Drawing Review," PTO-948, forwarded as part of paper number 7 on August 14, 2000. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

### ***State of Reasons for the Indication of Allowable Subject Matter***

6. The following is a statement of reasons for the indication of allowable subject matter:

While prior art was disclosed which disclosed an electronic intermediated exchange of a plurality of commodities among a plurality of participants through negotiations by receiving offers and counter-offers from the participants through an intermediary, according to the Board Decision of June 18, 2004 the cited prior art did not disclose that the intermediary, not the negotiating parties, **generated** and sent a series of offers to both of the participants based on responses (counter-offers) from the participants. An additional search of the prior art failed to locate any other disclosure in which the intermediary **generates** and sends a series of the offers to the participants

instead of merely passing on the counter-offers receiving from the participants.

Therefore, the non-obvious novelty of the invention is to have an intermediary **generate** and send a series of offers to both of the two negotiating parties.

### **Conclusion**

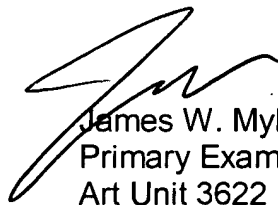
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.

  
JWM

November 10, 2004

  
James W. Myhre  
Primary Examiner  
Art Unit 3622

JOHN J. LOVE  
DIRECTOR  
TECHNOLOGY CENTER 3600

